

REMARKS

By the December 9, 2003 Office Action, Claims 1–23 remain rejected partially based on new grounds, i.e., U.S. Patent No. 5,974,547, issued to *Klimenko*. More specifically, Claims 1–23 were rejected under 35 U.S.C. §112, ¶1, as failing to comply with the enablement requirement; Claims 1, 2, 4–7, 12, 13, 15, and 17–22 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Stripf et al.*, U.S. Patent No. 6,263,487, in view of *Klimenko*, U.S. Patent No. 5,974,547; Claims 3, 14, 16, and 23 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Stripf et al.* in view of *Klimenko* as applied to Claim 1, and further in view of *Ditze, A Customizable Library to support Software Synthesis for Embedded Applications and Micro-Kernel Systems*; and Claims 8–11 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Stripf et al.* in view of *Klimenko* as applied to Claim 1, and further in view of *Deegan et al.*, U.S. Patent No. 6,055,632.

By this Amendment, Claims 1, 3, 12, 14–18, and 21–23 have been amended. No Claims have been added or withdrawn. As a result, Claims 1–23 remain at issue. All amendments to the Claims are fully supported by the originally filed Specification and no new matter has been added.

Applicant submits this Amendment to emphasize the novel and nonobvious features of the present invention in light of the rejection and position stated by the Examiner in the most recent Office Action. This Amendment raises no new issues that would require further consideration or an additional search and places this case in condition for allowance.

A. Rejections Under 35 U.S.C §112

Claims 1–23

Claims 1–23 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The enablement requirement of 35 U.S.C. §112, first paragraph, is separate and distinct from the description requirement. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563; 19 USPQ2d 1111, 1116–17 (Fed. Cir. 1991) (the purpose of the written description is broader than to merely explain how to “make and use.”) Therefore, the fact that a claim limitation may lack descriptive support in the disclosure as originally filed does not necessarily mean that the limitation is also not enabled. Consequently, such limitations must be analyzed for both enablement and description using their separate and distinct criteria.

Any analysis of whether a particular claim is supported by the disclosure in an application requires determination of whether that disclosure, when filed, contains sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. Furthermore, when the subject matter is not in the specification portion of the application as filed but is in the claims, the limitation in and of itself may enable one skilled in the art to make and use the claim containing the limitation. *MPEP* §2164.

The state of the art existing at the filing date of the application is used to determine whether a particular disclosure is enabling as of its filing date. Additionally, an applicant can offer expert testimony based on a publication as evidence of the level of skill in the art at the time the application was filed. *Gould v. Quigg*, 822 F.2d 1074, 1077 (Fed. Cir. 1987).

The standard for determining whether the specification meets the enablement requirement is whether undue or unreasonable experimentation is needed to practice the invention. *Mineral*

Separation v. Hyde, 242 U.S. 261, 270 (Supreme Court 1916). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661; 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). Determining enablement is a question of law based on underlying factual findings—*In re Vaeck*, 947 F.2d 488, 495 (Fed. Cir. 1991)—and the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation.

The examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993). It is incumbent on the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there is no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure. *In re Marzocchi*, 439 F.2d, 220, 224 (CCPA 1971). The examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation.

For the above reasoning, Applicant believes that Claims 1–23 comply with the enablement requirement of 35 USC §112. As such, Applicant believes Claims 1–23 are allowable and respectfully requests the removal of the rejections.

B. Rejections Under 35 U.S.C. §103

Claims 1,2, 4-7, 12, 13, 15, and 17-22

Claims 1, 2, 4-7, 12, 13, 15, and 17-22 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Stripf et al.* in view of *Klimenko*. Applicant has amended the Claims to more distinctly claim the invention and overcome the rejections.

Amended independent Claims 1, 12, 17, and 21 of the present application are directed to a control system of an automation network. The control system includes an operably connected automation device and a network device. The network device includes an application program for controlling the automation device. The automation device transmits a network address request message. An application program is selected in response to an application program request message further being responsive to the network address associated with the automation device.

Preferably, the network device is a server capable of storing one or more application programs and thus reduces or eliminates the need for the automation device to store its own application program. The application program includes an executive code and a user code, and each can be created or edited using the network device without requiring the resources of the automation device.

The cited reference of *Stripf et al.* discloses a globally distributed automation network wherein a control program comprises object-oriented software function blocks that facilitate the loading of the control program while it is executing. As admitted in the Office Action however, *Stripf et al.* fails to disclose at least an application program being selected in response to a network address of the automation device. Additionally, *Stripf et al.* further fails to disclose or suggest the desirability of such an attribute.

As such, the Office Action relies up *Klimenko* to overcome the shortcomings of *Stripf et al.* *Klimenko* is directed to an apparatus for booting an operating system (OS) to a computer, e.g., PC, on a network. *Klimenko* involves a field of art nonanalogous to that of *Stripf et al.* The mere fact that *Klimenko* and *Stripf et al.* each involve some type of a network is not an incentive to combine, nor is it a roadmap to combine selected elements of each in the manner suggested in the Office Action. To properly combine prior art references, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination of references feasible. This knowledge cannot come from the Applicant's invention itself. See *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992) (citing *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79 (Fed. Cir. 1988)); *In re Geiger*, 815 F.2d 686, 687 (Fed. Cir. 1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147 (Fed. Cir. 1985). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (citing *In re Gormyan*, 933 F.2d 900, 902 (Fed. Cir. 1984)).

The Office Action is unable to point to any incentive or motivation in *Stripf et al.* or *Klimenko* to make the proposed combination. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). When the motivation to combine the teachings of the references is not immediately apparent, it is

the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986).

There is no reason, suggestion, or motivation within either reference to combine or modify the teaching of either reference in view of the other. Thus, combination of the *Stripf et al.* and *Klimenko* is improper as there is no motivation in the references to combine them. *See In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1785 (Fed. Cir. 1995). Instead, isolated features from the nonanalogous cited references have been taken and used with the claims of the present application as a template. Such hindsight reconstruction is improper. It is well recognized that the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed device obvious. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); *Fine*, 837 F.2d at 1075 (“one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”)

As set forth above, there is no suggestion or motivation in the cited prior art to make the proposed combination. Moreover, there is no expectation of success if the references were in fact combined. The Office Action merely concludes Applicant’s combination is obvious and fails to show a teaching or motivation in the prior art to combine features of the prior art in the manner suggested in the rejections of independent Claims 1, 12, 17, and 21. *See In Re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (stating, “[o]ur case law makes clear that the best defense against the subtle but powerful attraction of hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”) The Examiner is required to provide evidence that is clear and particular as to why one skilled in the art would combine the references in the manner suggested. *Id.* (stating, “[t]he range of

sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.”). Instead, only conclusive statements are provided as to what the prior art would suggest to one of ordinary skill in the art. Such conclusive statements regarding teaching or motivation are insufficient. *Id.* (“Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’”)

Assuming for the sake of argument that it is proper to combine *Stripf et al.* and *Klimenko*, *Klimenko* still fails to disclose an application program for controlling an automation device being provided by a network device wherein the application program is selected in response to a request message further responsive to a network address associated with the automation device.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation—either in the references themselves or in the knowledge generally available to one of ordinary skill in the art—to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. And lastly, the prior art reference(s) must teach or suggest all of the claim limitations. The Examiner bears the initial burden on factually supporting any *prima facie* conclusion of obviousness. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, not in the applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The law is clear that the test for obviousness is whether the claimed invention as a whole, would have been obvious to one of ordinary skill in the art at the time the invention was made. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the modification suggested by the Examiner. “[T]he mere fact that the prior art could be so modified would not have made the

modification obvious unless the prior art suggested the desirability of the modification.” *In re Laskowski et. al.*, 10 U.S.P.Q. 2d 1397, 1398, (Fed. Cir. 1989), *citing*, *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). That motivation cannot come from the Applicant’s invention itself. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Thus, unless the references suggest the particular combination of elements themselves, they cannot render Applicant’s invention obvious. See *In re Mahurkar Patent Litigation*, 831 F.Supp. 1354, 1374, 28 USPQ2d 1801, 1817 (N.D. Ill. 1993).

As discussed above, none of the cited references teach, disclose, or suggest to modify—alone or in combination—Applicant’s claimed invention or its desirability. Because the cited prior art fails to disclose Applicant’s claimed invention, as amended, any modification suggesting Applicant’s claimed invention can only be a result of hindsight analysis. Such an analysis is insufficient to present a *prima facie* case of obviousness. Consequently, in view of the lack of such disclosure, it cannot be properly asserted that one skilled in the art would make the modification to the cited references to render Applicant’s invention obvious. Accordingly, Applicant respectfully requests that the §103 rejections of independent Claims 1, 12, 17, and 21 be removed and submits that these Claims are patentable over the cited prior art.

Claims 2–11, 13–16, 18–20, and 22–23 respectively depend on claims 1, 12, 17, or 21—either directly or indirectly—and include each of their respective limitations. Accordingly, based on at least the same reasons given for allowance of claims 1, 12, 17, or 21, Applicant respectfully submits claims 2–11, 13–16, and 18–20, and 22–23 are also patentable and request that the rejections be removed and the claims allowed.

Claims 3, 14, 16, and 23

Claims 3, 14, 16, and 23 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Stripf et al.* in view of *Klimenko* and further in view of *Ditze*. As discussed above, the combination of *Stripf et al.* and *Klimenko* is improper. And assuming for the sake of argument that the combination of *Stripf et al.* and *Klimenko* is proper, the addition of *Ditze* does not overcome the deficiencies of the combined references.

Stripf et al. and *Klimenko* have been discussed in detail above. And although it appears that *Ditze* may disclose a dependent element of the Applicant's claimed invention, *Ditze* fails to overcome the shortcomings of *Stripf et al.* and *Klimenko*, alone or in combination. Moreover, *Ditze* also involves art nonanalogous to *Stripf et al.* and the Applicant's claimed invention. As such, it does not follow that one skilled in the art would combine these references. Therefore, because the combination of *Stripf et al.* and *Klimenko* is improper, and the further addition of *Ditze* is also improper and does not overcome the deficiencies of the combined references, Applicant respectfully requests the rejections to Claims 3, 14, 16, and 23 be removed and the Claims allowed.

Claims 8-11

Claims 8-11 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Stripf et al.* in view of *Klimenko* and further in view of *Deegan et al.* Similar to the remarks above, the combination of *Stripf et al.* and *Klimenko* is improper. And assuming again for the sake of argument that the combination of *Stripf et al.* and *Klimenko* is proper, the addition of *Deegan et al.* does not overcome the deficiencies of the combined references.

Stripf et al. and *Klimenko* have been discussed in detail above. And although it appears that *Deegan et al.* may disclose a dependent element of the Applicant's claimed invention,

Deegan et al. fails to overcome the shortcomings of *Stripf et al.* and *Klimenko*, alone or in combination. Therefore, because *Stripf et al.*, *Klimenko*, and *Deegan et al.*—alone or in combination—fail to disclose Applicant's claimed invention, Applicant respectfully submits that Claims 8–11 are allowable.

CONCLUSION

In light of the above Amendments and Remarks, Applicant respectfully submits claims 1–23 are in condition for allowance and respectfully requests reconsideration and allowance of these Claims.

Respectfully submitted,

Date:

3/9/04

CERTIFICATE OF MAILING

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service with first class postage prepaid in an envelope addressed to Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 9, 2004.

Robert Holland
Robert Holland

195978

By:

Joseph M. Kinsella Jr.
Joseph M. Kinsella Jr., Reg. No. 45,743

phone: (312) 554-3300

Attorney for Applicant

Square D Company

1415 South Roselle Road

Palatine, Illinois 60067-7399

fax: (847) 925-7109